

Applic. No. 10/823,986
Amdt. dated September 19, 2005
Reply to Office action of June 20, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-33 remain in the application. Claims 1 and 24 have been amended.

In the second paragraph on page 2 of the above-identified Office action, claims 1-33 have been rejected as being obvious over Wickland (U.S. Patent No. 6,355,078 B1) in view of Breuer et al. (U.S. Patent No. 5,322,672) (hereinafter "Breuer") under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found on page 4, lines 19-21 and on page 29, lines 14-21 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 24 call for, *inter alia*:

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providing at least one covering layer formed with a given porosity and a resistance to temperatures of over 200°C ... and placing at least one fiber layer made of a fiber fabric and having a resistance to temperatures of over 200°C on the at least one covering layer.

The Wickland reference discloses a bag for containing nuclear waste including a filter media (52). The filter media (52) is implemented as a wafer with split polypropylene fibers with a permanent electric charge (column 3, lines 57-64). The filter media (52) is disclosed as being a HEPA filter, the material of the HEPA filter is a proprietary split polypropylene fiber material with a permanent electric charge (column 3, lines 34-42).

Accordingly, the filter medium disclosed by Wickland is not capable of withstanding temperatures of over 200°C, because the materials used by Wickland have much lower melting points. A filter as disclosed by Wickland cannot withstand the conditions in the exhaust system of internal combustion engines.

Moreover, Wickland discloses that the strips (46 and 48) are made of a polyurethane number 8125 having a thickness of 0.008 inch (column 3, lines 47-49). Therefore, since the strips are

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made of a polymer, they are not resistant to high temperatures.

It is noted that the assignee of the instant application is also the corporate assignee of the Breuer reference. Therefore applicant is very familiar with the Breuer reference.

The Breuer reference discloses a honeycomb body assembly having layered metal sheets forming a stack with a plurality of channels through which a fluid can flow (abstract).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest providing at least one covering layer formed with a given porosity and a resistance to temperatures of over 200°C and placing at least one fiber layer made of a fiber fabric having a resistance to temperatures of over 200°C on the at least one covering layer, as recited in claims 1 and 24 of the instant application.

As seen from the above-given comments, the Wickland reference discloses a filter medium that is not capable of withstanding

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temperatures over 200°C. Wickland discloses a covering (46 and 48) is not capable of withstanding temperatures over 200°C. This is contrary to the invention of the instant application as claimed, which recites providing at least one covering layer formed with a given porosity and a resistance to temperatures of over 200°C and placing at least one fiber layer made of a fiber fabric having a resistance to temperatures of over 200°C on the at least one covering layer.

The Breuer reference discloses a honeycomb body having layered metal sheets with a plurality of channels. Breuer does not disclose a porous cover layer and a fiber layer that is resistant to temperatures of up to 200°C. This is contrary to the invention of the instant application as claimed, which recites providing at least one covering layer formed with a given porosity and a resistance to temperatures of over 200°C and placing at least one fiber layer made of a fiber fabric having a resistance to temperatures of over 200°C on the at least one covering layer.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

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Furthermore, a person of ordinary skill in the art would not combine the teachings of Wickland and Breuer. Wickland explicitly discloses that his invention has applications to any other storage arrangement or container in which a bag is vented or in which an enclosure other than a bag is vented (column 4, lines 11-16). Wickland does not provide a person of ordinary skill in the art any motivation for providing a high temperature resistant filter (at least 200°C) for use in the exhaust systems of internal combustion engines. Therefore, a person of ordinary skill in the art would not be motivated to use the teaching of Wickland in an exhaust system of an internal combustion engine.

Moreover, a critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting

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W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540,
1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffat, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS

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Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 24. Claims 1 and

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24 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 24, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-33 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,


For Applicant(s)

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